

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional): P114-US	
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		First Named Inventor: <div style="text-align: center; font-weight: bold;">Mathieu</div>	
		Art Unit: <div style="text-align: center; font-weight: bold;">3726</div>	Office Action: <div style="text-align: center; font-weight: bold;">Rick K. Chang</div>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. <small>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</small> </div> <div style="width: 35%; text-align: center;"> <u>/N. Kenneth Burraston/</u> Signature <u>N. Kenneth Burraston</u> Typed or printed name <u>(801) 323-5934</u> Telephone number <u>November 6, 2007</u> Date </div> </div> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <input checked="" type="checkbox"/> attorney or agent of record. Registration number: <u>39,923</u> </div> <div style="width: 35%;"></div> </div> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: <u>39,923</u> </div> <div style="width: 35%;"></div> </div>			
Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> form(s) are submitted.			

ARGUMENTS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW

In support of Applicants' Pre-Appeal Brief Request For Review of the final rejection in the Office Action dated October 22, 2007 (hereinafter the "Office Action") in the above-identified patent application, Applicants respectfully submit the following:

I. Background:

Claims 71-75, 77-88, and 102-121 are pending of which only claim 71 is independent. In the Office Action, the Examiner withdrew all previous rejections but rejected all of the pending claims under 35 § USC 112, second paragraph. The claims were not rejected on any other grounds.

II. Argument:

The Examiner found only claim 71 to be indefinite. The Examiner asserts three grounds for finding claim 71 indefinite. First, the Examiner states that "said adjusting a shape of a surface of a first of said substrates" in line 5 of claim 71 "lacks positive antecedent bases. Second, the Examiner states that it is unclear whether "said surface of said first substrate" in lines 7 and 8 refers to the prior recitation of "surface of said first substrate" in line 4 or line 5 of claim 71. Third, the Examiner states that "said surface of said first substrate" in lines 7 and 8 of 71 lacks positive antecedent basis. Applicants traverse this rejection and assert that each claim element has proper antecedent basis and is otherwise sufficiently clear to meet the requirements of 35 USC 112, second paragraph.

Turning to the first grounds for finding claim 71 indefinite, Applicants note that claim 71 reads as follows:

Claim 71: A method of planarizing probes, wherein said probes are disposed to correspond to terminals of one or more devices to be tested and said probes are disposed on a plurality of substrates, said method comprising:

adjusting a shape of a surface of a first of said substrates without contacting said one or more devices to be tested, wherein said adjusting a shape of a surface of a first of said substrates changes a planar orientation of a contact portion of one of a first plurality of said probes is attached to said surface of said first substrate relative to another one of said first plurality of probes attached to said surface of said first substrate; and

adjusting a shape of a surface of a second of said substrates, wherein a second plurality of said probes is attached to said surface of said second substrate. (Emphasis added.)

In rejecting claim 71, the Examiner indicated that the underlined portion above does not have positive antecedent basis. The bolded-italized portion of claim 71 above, however, provides unmistakable antecedent basis for the underlined portion. That is, the bolded-italized portion of claim 71 above recites an action, namely, "adjusting a shape of a surface of a first of said substrates." The underlined portion of claim 71 above refers to that action. Therefore, "said adjusting a shape of a surface of a first of said substrates" has clear antecedent basis in the claim, and the first grounds for finding claim 71 indefinite is without basis.

Turning to the second grounds for finding claim 71 indefinite, Applicants note that the underlined portion in claim 71 above refers back to the bold-italized portion. It is as if claim 71 read as follows: ***an action (namely, adjusting a shape of a surface of a first of said substrates)*** . . . , wherein said action (namely, adjusting a shape of a surface of a first of said substrates) changes a planar orientation Thus, the second recitation of "a surface of a first of said substrates" on line 5 of claim 71 clearly does not introduce a new surface but is merely part of the description of the action (namely, adjusting a shape of a surface of a first substrate) previously introduced on line 4 of claim 71 and then referred to again on line 5. Thus, "said adjusting a shape of a surface of a first of said substrates" on line 5 is not introducing a new surface but is merely identifying the previously recited (on line 4) action of "adjusting a shape of a surface of a first of said substrates." Later references to "said surface of said first substrate" are clearly referring to the surface of the first substrate whose shape is adjusted by the action of "adjusting a shape of a surface of a first of said substrate," which action is first introduced on line 4 and later referred to again at line 5. The second grounds for finding claim 71 indefinite is therefore without basis.

The third grounds for finding claim 71 indefinite is that "said surface of said first substrate" allegedly lacks antecedent basis. The Examiner's second grounds, however, undermines the third grounds. That is, in the second grounds for finding claim 71 indefinite, the Examiner states that it is not clear whether "said surface of said first substrate" refers to a recitation on line 4 or line 5, which is a clear acknowledgement by the Examiner that there is a prior recitation of "said surface of said first substrate" on both line 4 and line 5 of claim 71. Moreover, "said shape" refers to "a shape" first recited on line 4 of claim 71, and "said first substrate" refers to "a first of said substrates" also first recited on line 4 of claim 71. The third grounds for finding claim 71 indefinite is therefore without basis.

For at least the foregoing reasons, each of the Examiner's grounds for finding claim 71 indefinite are baseless, and the rejection should accordingly be withdrawn.

Applicants note that, as set forth in the MPEP, "[t]he essential inquiry pertaining to this requirement [the second paragraph of 35 USC 112] is whether the claims set out and circumscribe a particular subject matter *with a reasonable degree of clarity and particularity*." (MPEP § 2703.02 (emphasis added).) The "examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." (MPEP § 2703.02.) Moreover, "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." (MPEP § 2703.02.) Applicants respectfully assert that claim 71 sets out and circumscribes the claimed subject matter at least "with a reasonable degree of clarity and particularity," and as discussed above, there are no grounds for requiring a change in the language of claim 71.

III. Conclusion:

In view of the foregoing, Applicants respectfully submit that all of the claims are definite and in condition for allowance. Consequently, Applicants request that the rejections of the claims be withdrawn and all claims allowed.